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Paper No. 19

In re Application of: Ju-Heon Lee)
Application No. 09/685,138) DECISION ON PETITION FOR
Attorney Docket No. P56181) SUPERVISORY REVIEW REGARDING
Filed: 10/11/2000) FINALITY OF RESTRICTION
For: PORTABLE INTEGRATED CIRCUIT) REQUIREMENT UNDER 37 CFR
MEMORY DEVICE FOR USE WITH) §1.144
UNIVERSAL SERIAL BUS)

This is in response to the petition filed on February 18, 2004, under 37 CFR 1.144 requesting supervisory review of the finality of a restriction requirement mailed on October 29, 2003. Note, A petition under 37 CFR §1.144 will not be considered if reconsideration of the requirement was not requested (see §1.181).

The petition is **GRANTED**.

RECENT PROSECUTION HISTORY

- (1) A non-final first office action on the merits was mailed on February 27, 2003, in which claims 1-20 were rejected on prior art.
- (2) Applicant filed a request for acknowledgement of the foreign priority document on March 6, 2003.
- (3) A miscellaneous office letter was mailed on April 17, 2003 acknowledging the priority document.
- (4) An amendment (A) was filed on May 19, 2003. In the amendment, claims 3 and 9-15 were cancelled, claim 1 was amended and claims 21-30 were added (claim 25 being an independent claim).
- (5) In response to amendment (A), the Examiner mailed a combination restriction requirement and species election on July 8, 2003. In the restriction, the Examiner grouped the claims according to the following: (Group I – drawn to claims 1-11 & 21-24, Group II – drawn to claims 12-15, and Group III – drawn to claims 16-20 & 25-30); and in the species election, six different species were identified based upon the 11 various figures in the instant application.

(6) In response to the combination restriction and species election of July 8, 2003, Applicant filed an amendment (B) and request to withdraw the restriction requirement under 37 CFR §1.143 on September 3, 2003. The amendment added new dependent claims 31 and 32, subsequently identified by the Examiner to be linking claims. Applicant also provisionally elected Group III (claims 16-20 & 25-30) and specie 6, with traverse, and provided supporting arguments for such traversal and request to withdraw.

(7) On October 29, 2003, the Examiner mailed a second non-final office action containing a modified combination restriction requirement and species election according to the following: (Group I – drawn to claims 1-2, 4-11 and 21-24, Group II – drawn to claims 16-20 and 25-30, Group III – drawn to claim 31, and Group IV – drawn to claim 32). The species election remained as set forth in the requirement of July 8, 2003 (six identified species based upon the 11 figures in the instant application). Utilizing Applicant's previous (provisional) election on September 3, 2003, i.e. election with traverse of group II (previously recited (by the Examiner) as group III) and specie 6, the Examiner treated claims 16-20 and 25-29 (note, claim 30 identified in this action as now being withdrawn by the Examiner as not pertaining to specie 6). This office action determined the requirement for restriction to be proper and therefore was made FINAL. In addition, this office action included a rejection of claims 16-20 and 25-29 on prior art.

(8) On February 10, 2004, a telephone interview summary was mailed wherein the summary indicates that Applicant presented arguments against the prior art used in the rejection of record as well as regarding the withdrawal of claim 30 with the restriction requirement of October 29, 2003.

(9) On February 18, 2004, the instant petition was filed by Petitioner under 37 CFR §1.144.

RELIEF REQUESTED

The instant petition under 37 CFR 1.144 requests the following relief:

- (1) withdrawal of the restriction requirement of October 29, 2003;
- (2) withdrawal of the species requirement of October 29, 2003;
- (3) as a result of items (1) and (2) above, examination of the pending claims.

ANALYSIS

Petitioner provides various arguments in support of the withdrawal of the election/restriction requirement including reference to 37 CFR 1.146 and M.P.E.P. 806.03. 37 CFR 1.146 states:

In the first action [emphasis added] on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application.

M.P.E.P. 806.03 sets forth: Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction there between should

never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

Finally, M.P.E.P. 809 states in part: Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required. *A letter including only a restriction requirement or a telephoned requirement to restrict* (the latter being encouraged) *will be effected, specifying which claims are considered linking.* See MPEP § 812.01 for telephone practice in restriction requirements. The linking claims *must be* examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn.

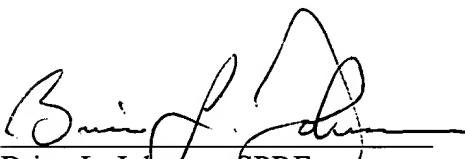
Note, the species election of July 8, 2003 and October 29, 2003 were presented to the Applicant by the Examiner subsequent to the first office action, non-final rejection (of all pending claims) of February 27, 2003. In addition, all figures of the instant application appear to be drawn to single disclosed embodiment of the invention. Thus, and in accordance with M.P.E.P. §806.03 and 37 CFR §1.146, the species election appears to be improper and extraneous.

Finally, since the election/restriction requirement was modified in the office action of October 29, 2003 to include the identification of linking claims, which were not subsequently examined in the office action of October 29, 2003 and since the Applicant has not been given an opportunity to respond to the modified requirement, the restriction requirement of October 29, 2003 is deemed to be improper.

The petition is **GRANTED**. The election/restriction requirement of October 29, 2003 is **withdrawn**.

The application is being forwarded to the Examiner for appropriate action i.e. prosecution of the pending claims consistent with this decision.

Any inquiries related to this decision may be directed to the undersigned at (703) 308-0885.



7/21/04
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